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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/612,772

07/02/2003

William A. Montemer

1003-P0003US

5008

21912 7590 02/22/2008  
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EXAMINER

RAJ, RAJIV J

ART UNIT

PAPER NUMBER

4143

MAIL DATE

DELIVERY MODE

02/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/612,772	MONTEMER, WILLIAM A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	RAJIV J. RAJ	4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07 June 2004, 29 June 2004, 04 January 2005</u> .             | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 02 June 2003.
2. Claims 1-2 are currently pending and have been examined.

### **Information Disclosure Statement**

3. The Information Disclosure Statements filed 07 June 2004, 29 June 2004, and 04 January 2005 have been considered. Initialed copies of the Form 1449 is enclosed herewith.

### **Priority**

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Claim Rejections - 35 USC § 101**

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 2 is rejected under 35 U.S.C. 101 because a claim can not be directed to embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101. 35 U.S.C. 101 is drafted so as to set forth the statutory classes of invention in the alternative only. See MPEP § 2173.05(p)(II).

### **Claim Rejections - 35 USC § 112**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.

### **Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soulanille (US 2001/0051940 A1) (hereinafter Soulanille) in view of Padden et al. (US 4979206) (hereinafter Padden).

#### **Claim 1**

**Soulanille as shown, discloses the following limitations:**

- *maintaining a database including a plurality of directory listings, (see at least Soulanille [0042] "In a preferred embodiment of the present invention, search engine web server 24 includes a search database 40 comprised of search listing records used to generate search results in response to user queries.")*
- *wherein each listing is associated with a referral phone number, at least one keyword and a bid amount a directory listing owner is willing to pay for a single telephone referral; (see*

at least Soulanille [0016] "In a database of search listings in which each search listing is associated with an advertiser and includes at least one search term and a bid amount by the advertiser, search listings generating a match with the search request are identified.")

- *receiving a directory assistance request in the form of a keyword from the customer;* (see at least Soulanille [0016] The method includes receiving a search request from a searcher . . . includes at least one search term")
- *identifying the directory listings having keyword terms generating a match with the request;* (see at least Soulanille [0017] "identifying search listings having search terms generating a match with the search request.")
- *ordering the identified directory listings into a phone number result list in accordance with the values of the bid amounts for the identified directory listings;* (see at least Soulanille [0018] "arranging as the search result list the identified search listings for display in a random order weighted according to the bid amount associated with each respective identified search listing.")
- *selecting one of the directory listings;* (see at least Soulanille [0018] "The method further includes selecting according to bid amount a variable number of identified search listings for display to the searcher, wherein the number of selected identified search listings is a function of the bid amounts for the identified search listings.")
- *generating a paid referral business transaction and associating it with the listing owner's advertising account;* (see at least Soulanille [0044] "Most preferably, the advertiser's web site description and hyperlink on the search result list page is accompanied by an indication that the advertiser's listing is a paid listing. Most preferably, each paid listing displays a "cost to advertiser," which is an amount corresponding to a "price-per-click" paid by the advertiser for each referral to the advertiser's site through the search result list.")
- *generating one or a plurality of derivative business transactions to execute the business processes involved in the referral transaction.* (see at least Soulanille [0014 & [0012] "A consumer utilizing a search engine that facilitates this on-line marketplace will find companies or businesses that offer the products, services, or information that the consumer is seeking." & "The banner may act a hyperlink a visitor may click on to access the site. Like traditional advertising, banner advertising on the Internet is typically priced on an impression basis with advertisers paying for exposures to potential consumers.")

Soulanille does not disclose the following limitation, however Padden, as shown, does:

- *a directory assistance request from a telephone customer using a computer network* (see at least Padden Column:1 Lines 13-17 "a customer places a call to an operator and gives

the particulars of a request for a directory listing and the operator keys identifying data into a computer for locating directory listings.”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations, as taught by Soulanille, with *a directory assistance request from a telephone customer using a computer network*, as taught by Padden, with the motivation of increasing the efficiency and effectiveness of delivering relevant information to interested parties in a cost-effective manner (Soulanille [0013]).

## **Claim 2**

**Soulanille as shown, discloses the following limitations:**

- *encapsulating the business transaction parameters in a separate transaction container that can be passed as a complete package to disparately located business transactions; sending the transaction container to one or a plurality of business processes; after executing the business process, including the resulting system state as the transaction context for the particular business process; adding successive transaction contexts to the transaction container in such a way that the sequence of initial state, desired operation, input parameters and resulting state fully describes each step of the multi-step distributed transaction. (see at least Soulanille [0115] “This pseudocode and the method illustrated in FIG. 10 may be adapted to any suitable embodiment. In particular, it may be adapted as program code in C++ or Java implemented on a web server and operated by a pay for performance search engine operator” wherein object-oriented programming, such as C++, naturally discloses the steps of packaging, transporting, and adding additional business transactions.)*

Soulanille does not disclose the following limitation, however Padden, as shown, does:

- *a directory assistance request from a telephone customer using a computer network (see at least Padden Column:1 Lines 13-17)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations, as taught by Soulanille, with *generating one or a directory assistance request from a telephone customer using a computer network*, as taught by Padden, with the motivation of

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increasing the efficiency and effectiveness of delivering relevant information to interested parties in a cost-effective manner (Soulanille [0013]).



### Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **571-270-3930**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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Date: 02/18/08

/Rajiv J Raj/ Patent Examiner Art Unit 4143

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143